

REMARKS

Applicant has reviewed the Office Action of December 2, 2003 and offers the following remarks in response thereto. Before addressing the rejections based on the references, Applicant provides a brief summary of the invention as well as a summary of the primary references so that the remarks are provided in the proper context.

Summary of the Invention

The present invention is directed to a system and method that allows an individual to use a credit card or debit card during a transaction at a fueling environment. While normally it is impossible for people that use such cards to enjoy a concurrent cash transaction, the present invention allows the card user to participate in a concurrent cash transaction. Specifically, the present invention allows the card user to add a "cash back" transaction to the card transaction at the fueling environment. By affirmatively requesting cash back, the card user may select an amount of cash to be received. If the total cost of the transaction and the cash back transaction is approved by the financial institution associated with the card, the user then receives the cash, either from a cash dispenser at or near the fuel dispenser or from a central dispenser. While cash back transactions have become common in the past year or so, at the time of conception and at the time of filing (March 29, 1999), cash back transactions were not common and were not obvious in the context of a fueling environment.

Ramsey et al.

Ramsey et al. is directed to a fuel dispenser that accepts credit cards and cash. When a cash transaction occurs, the fuel dispenser can dispense change to the customer. Ramsey deals with the two systems separately and provides no indication that the two systems can be used concurrently in a single fueling transaction. At column 12, lines 14-35, the reference specifically indicates that the systems cannot be used concurrently. At lines 29-33, the reference indicates with great particularity that the cash console is disabled in the event of a card transaction.

Bohnert et al.

Bohnert et al. is directed to a fueling environment that has a central island transaction terminal. The island transaction terminal has a card reader and a cash acceptor, both of which

can be used to pay for a fueling transaction. Change may be returned to the user in the event that the user has overpaid for a fueling transaction. For example, if the user pays using a twenty dollar bill, but only pumps \$14.64 in gas, the terminal may return \$5.36 in change. Nothing in Bohnert et al. teaches or suggests that a card can be used in conjunction with a cash transaction or vice versa.

Muehlberger et al.

Muehlberger et al. is a counter-top terminal system that is designed to perform debit card sales transactions. The counter-top card terminal is designed so that it can be used in smaller specialty stores and avoid high credit card transaction fees. This system is not designed for use in a fuel dispensing environment. This reference does indicate at column 3, lines 47-52 that the customer may receive cash back as part of a card transaction.

§ 103

Rejection

Claims 1, 2, 4, 5, 11-17, 19-24 were rejected under 35 U.S.C. § 103 as being unpatentable over Ramsey et al. (hereinafter "Ramsey") in view of Bohnert et al. (hereinafter "Bohnert") and Muehlberger et al. (hereinafter "Muehlberger"). Claim 3 was rejected under 35 U.S.C. § 103 as being unpatentable over the combination of the Ramsey, Bohnert and Muehlberger with Baker et al. (hereinafter "Baker"). Claims 5, 7-10, and 18 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Ramsey, Bohnert, and Muehlberger with Bustos et al. (hereinafter "Bustos"). Applicant respectfully traverses. As the rejection of claims 1-24 depends on the combination of Ramsey, Bohnert and Muehlberger, if Applicant can show that this combination is improper, then the rejections of all the claims is improper.

Standards

For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located. MPEP § 2143.03. When making a rejection, the Patent Office is obligated to consider references in their entireties. MPEP § 2141.02. Specifically, portions of a reference which teach away from a potential combination cannot be ignored. *Id.* In the present case, as will be explained below, Ramsey has portions therein which

teach away from the combination advanced by the Patent Office. Furthermore, even if Ramsey does not teach away from the combination, the Patent Office must advance a reason to combine the references. This reason must come from the prior art and not from Applicant's disclosure. MPEP § 2143.01. Furthermore, this reason must be supported by objective evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In the present case, the motivation advanced by the Patent Office relies on impermissible hindsight. Still further, if a reference must be modified, then the Patent Office must provide additional objective evidence as to why the modification is obvious. *Id.* Still further, it is improper to modify a reference such that it is no longer suitable for its intended purpose. MPEP § 2141.02. In the present case, the Patent Office's proposed combination renders one of the references unsuitable for its intended purpose, and thus, the modification advanced by the Patent Office is not obvious.

Analysis

Applicant previously argued in the response filed September 22, 2003 that the Patent Office was not free to ignore the portions of Ramsey (column 12, lines 14-35) that teach away from the combination. Specifically, Applicant argued that since Ramsey disables the cash dispenser in the event of a card based transaction, the cash dispenser could never dispense cash back. If the cash cannot be received as change in a card transaction because the cash dispenser has been disabled, then the claimed cash back feature cannot be used in Ramsey's device. The Patent Office responded in paragraph 6 (pp. 3-4) of the Office Action of December 2, 2003 by stating that replacing the card acceptance means of Ramsey with that as taught specifically by Muehlberger would not render Ramsey unsuitable for its intended purpose. However, this statement misapprehends Applicant's argument. Applicant noted that modifying *Muehlberger*, not *Ramsey*, would render *Muehlberger* unsuitable for its intended purpose and that this modification was evidence of non-obviousness. Applicant's argument with respect to the combination of Ramsey and Muehlberger was more fundamental. MPEP § 2141.02 indicates that the Patent Office is not free to ignore portions of the reference. In this case, the Patent Office is ignoring the portion of Ramsey that indicates that the cash dispenser is disabled when a card is used in the card reader. Ramsey stresses this is an "important" feature (see column 12, line 16), and it should not be overlooked by the Patent Office. This portion of the reference thus teaches away from any sort of combination or modification to Ramsey that would allow the cash

dispenser to work concurrently with a card transaction. To this extent, it is improper to combine Ramsey with any device that concurrently operates the cash dispenser and the card transaction apparatus. Since the combination is improper, and the references individually do not establish *prima facie* obviousness, the claims are allowable.

Applicant further argued in the response filed September 22, 2003 that, even if Ramsey did not teach away from the combination, the Patent Office has not provided the requisite motivation to combine the references in the manner that the Patent Office suggests. Specifically, Applicant argued that the Patent Office was using Applicant's disclosure as the basis to combine the references. Applicant maintains that this is still true. In the response to Applicant's arguments in the latest Office Action, the Patent Office does little to address this point other than to point out that

it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include *knowledge gleaned only from the applicant's disclosure*, such a reconstruction is proper.

(Office Action of December 2, 2003, p. 4, paragraph 7, emphasis added). As the Federal Circuit has stated in *In re Dembiczak*, the Patent Office must present *objective* evidence that suggests a combination of references. In the present case, the Patent Office has advanced *no* evidence at all that suggests combining the references, offering only the Patent Office's opinion as to why the references should be combined. Further, this opinion, since it is not supported by any objective evidence, seems to be *gleaned only from the applicant's disclosure*. The failure to present any evidence is improper. Since the Patent Office has not provided the requisite evidence, the combination is improper. Since the combination is improper, the references must be considered for what they teach and suggest individually, and individually the references do not teach or suggest all the claim elements. Since the references individually do not teach or suggest all the claim elements, the Patent Office has not established *prima facie* obviousness, and the claims are allowable over the rejection of record.

Applicant further argued that even if the Patent Office was not relying on impermissible hindsight, the Patent Office, in its combination, has modified Muehlberger to the point where Muehlberger no longer serves its intended purpose. This remains evidence of non-obviousness. Specifically, Muehlberger's intended purpose, as evidenced by the title, the first line of the

abstract, and the first paragraph of the Summary (column 1, lines 54-60), is to provide a counter-top card terminal. The counter-top card terminal is designed so that it can be used in smaller specialty stores and avoid high credit card transaction fees. By modifying Muehlberger to work in a fuel dispenser, Muehlberger's device is no longer suitable for use as a counter-top device. Thus, the Patent Office's modification renders Muehlberger unsuitable for its intended purpose. This is yet another reason why the combination advanced by the Patent Office is improper and the claims are allowable. The Patent Office did not address this in its response, indicating that Ramsey is still suitable for its intended purpose. Applicant did not argue Ramsey's suitability, so this assertion is moot. The issue in this argument is whether the modification to Muehlberger that made Muehlberger unsuitable for Muehlberger's intended purpose precluded the modification. As MPEP § 2141.02 indicates, such a modification is evidence of non-obviousness. Since the modification purported by the Patent Office is actually evidence of non-obviousness, the claims define over the rejection of record and are allowable.

Further, even if the modification did not render Muehlberger unsuitable for Muehlberger's intended purpose, the Patent Office is still obligated to provide objective evidence as to the location of the suggestion to combine Muehlberger with Ramsey and Bohnert. The Patent Office has provided no such objective evidence as required by *Dembiczak*. Since the Patent Office has not provided the requisite objective evidence, the combination is improper and the references must be considered individually. Since the references individually do not teach or suggest all the claim elements, the claims are allowable.

Even if the Patent Office had provided the requisite objective evidence to combine Muehlberger with Ramsey and Bohnert, the Patent Office has, as explained above, modified Muehlberger. *In re Dembiczak* requires that the Patent Office provide additional objective evidence that a reference be modified after combination. The Patent Office has provided no such objective evidence and thus, the combination of the references results in a counter-top cash back terminal, not one in a fuel dispenser as claimed. Since the combination of references does not teach the claimed invention, the combination does not establish *prima facie* obviousness. Since the combination without modification does not establish *prima facie* obviousness and the Patent Office has not provided the evidence to support a modification, the claims are allowable.

The Patent Office has not established *prima facie* obviousness with respect to the claims at issue and the claims are allowable. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,
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